



## **BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI**

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### **Jurisdiction**

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the Circuit Court of Appeals for the Second Circuit which petitioner seeks to have reviewed was entered December 12, 1941 (R. 519).

### **Statement of the Case**

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

### **Specification of Errors**

The errors which petitioners will urge if the writ of certiorari is issued, are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding that the scope of claim 1 is limited by "file wrapper estoppel" to the precise construction illustrated and described in the drawings and specification.
2. In not according to the terms of claim 1 of Patent No. 1,964,911 the meaning expressly set forth in the definitions included in the specification of the patent.
3. In not holding defendants' device to be an infringement of claim 1 of Patent No. 1,964,911.

## Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari.

## ARGUMENT

### I

The ruling of the Court of Appeals for the Second Circuit denying to the patentee the benefit of a range of equivalents within the scope of the language of the claim is in direct conflict with the ruling of this Court in *Exhibit Supply Company v. Ace Patents Corporation*, decided February 2, 1942 (86 L. Ed. 453, *Advance Sheets*).

In the above mentioned case this Court reviews its former decisions dealing with the question of file wrapper estoppel and restates the governing principles particularly as regards the limits of the estoppel. In view of this recent and comprehensive discussion of the question any reference to prior authorities in this argument would be superfluous.

A file wrapper estoppel is created by an applicant for a patent when he limits the scope of the monopoly defined by his patent claims to meet the objection of the Patent Office that his claims are broader than he is entitled to. As clearly stated by this Court in the above mentioned case, he is not, however, by this action, estopped from claiming *all* benefit of the doctrine of equivalents in construing his claims against infringers. His amendment *limits* the range of equivalents to those structures which fall within the terms of the amended claims, but his patent is infringed by those structures.

In the case at bar the Court of Appeals in its opinion expressly holds that the claim in suit *cannot* be given a construction commensurate with its terms but must be construed as limited to the precise embodiment of the invention illustrated in the drawings.

The device of the patent is a simple article of manufacture. A string is attached to a strip of cotton three or four inches in length, which is then compressed under heavy hydraulic pressure, 2500 pounds to the square inch (R. 24), to a self-sustaining cylindrical plug of a length less than half that of the original strip. Upon the absorption of liquid the plug expands again to its original dimensions, and in so doing it absorbs two or three times its own volume of liquid (R. 34, 309). The advantages of the structure are not in dispute, as is evident from the advertising and direction leaflets of both parties (R. 297, 316).

In compressing a strip of cotton to a shorter length, folds are inevitably produced in the material of the strip. The inventor in his specification and claims used the word "convoluted" to define the folding effected by this longitudinal compression of the strip. The Examiner expressed disagreement with the meaning of the word "convoluted" and suggested that such folds were better defined as "accordion folds". Instead of amending the claim to adopt the Examiner's phraseology, the patentee incorporated in the specification a definition of the word "convoluted" as used in the patent claim (R. 209) to include accordion folds\* which, according to the Examiner, are the "natural result of compressing a long strip into a tight core of considerably lesser length". The Court of Appeals so construed the *language* of the claim in its opinion:

"The examiner rejected the claim because he did not like the use of the word, 'convoluted', which to him meant folded like a leaf, 'vernated'. He preferred the word, 'accordion', and said that 'accordion folds are the natural result of compressing a long strip \* \* \* into a tight core of considerably lesser length.' To meet this objection Haas kept the word, 'convoluted', in the claim, but defined it as we have said. If that

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\*"The words 'convolutions' and 'convoluted' as used herein mean—folded in curved or tortuous, sinuous windings, that is, bending in and out in a serpentine, wavy or accordion folded form."

was all, it might be difficult to say that the introduction of the definition had circumscribed the claim to the kind of 'convolutions' described in 'the second passage' ". (Emphasis ours) (Opinion R. 505-506)

The Court of Appeals held, however, that the claim could not be accorded a scope commensurate with its language because of the incorporation in the description and drawings of the second application in which the claim was allowed, of additional descriptive matter not included in the specification of the original application. This descriptive matter is designated as the "second passage" in the Court's opinion and is quoted in the opinion (R. 505).

"The next step in the manufacture of the device is to fold the pad 11 into convolutions such as shown in Fig. 2 to reduce the length thereof. This folded convoluted pad is then placed into a die and pressed under high pressure from both the sides and the end to form a hard cylindrical core 13 with the withdrawing member 12 extending therefrom".

Figure 2 discloses a procedural step in the manufacture of the specific device disclosed in the patent drawings, namely, a pre-folding of the strip to facilitate its insertion and compression in the forming die. This procedural step is recited in claims 2 and 3 of the patent, and these claims are not charged to be infringed. The folds shown in Fig. 2 are described in the Court's opinion (R. 505) as "*regular zigzag folds*" and the Court held claim 1 limited to the "*regular zigzag folds*" disclosed in Figure 2, notwithstanding the broader language of the claim, thereby excluding from the claim an equivalent form of the device *recognized by the patentee and the Patent Office* as within the scope of the claim language, namely, a compressed strip wherein the folds are not regular, zigzag folds, but are the haphazard folds which are "the natural result of compressing a long strip into a tight core of considerably lesser length."

In *Exhibit Supply Company v. Ace Patents Corporation*, *supra*, the petitioner urged that the amendment of the claim to conductor means "embedded in the table" instead of "carried by the table", limited the claim to the precise form of conductor means disclosed in the drawings of the patent, which was a metal ring embedded in the table top. This Court rejected that contention and held the claim to be infringed by all forms of defendant's devices to which the language of the claim properly applied.

The error of the Court of Appeals for the Second Circuit in the case at bar is plain. The added drawing and the description which the Court designates as "the second passage" was not included to meet a rejection of the claim as too broad, but in order to meet the Examiner's criticism of the specification of the first filed application as an insufficient disclosure. In meeting that objection the patentee complied with the statutory requirement that he disclose in detail the preferred embodiment of his invention.\*

Even the broadest and most basic invention must be disclosed in detail to comply with the statute, but the scope of the patent, whether generic or specific, is determined by the claims of the patent and not by the details of the particular embodiment selected for illustration. **It is impossible to illustrate a genus in a drawing without also illustrating a species.** *One may make a word picture of a genus to include several species, and the patent claim, according to the American patent procedure, is intended to be such a word picture.* If the ruling of the Court of Appeals

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\*Sec. 4888. (U. S. C., title 35, sec. 33.) Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle . . ." (Emphasis ours)

for the Second Circuit is allowed to stand, any addition to the description and drawing of a patent application will create a file wrapper estoppel so limiting the patent that it can be infringed only by an exact Chinese copy of the particular device selected for illustration.

## II.

**The ruling of the Court of Appeals for the Second Circuit that additions to the specification and drawings create a file wrapper estoppel limiting the claim to the precise structure illustrated is in direct conflict with decisions of Courts in the First and Third Circuits.**

In *Manhattan General Construction Co. v. Helios-Upton Co.*, 135 Fed. 785, the precise question here presented arose before the Circuit Court for the Eastern District of Pennsylvania. The ruling of that Court was directly contrary to the ruling here.\*

On a similar state of facts the District Court for the District of Massachusetts in the case of *A. S. Boyle Co. v. Siegel Hardware & Paint Co.*, 26 F. Supp. 217, also held that amendments to the specifications did not create an estoppel unless incorporated in the claims to secure their allowance.

These cases are consistent with the doctrine of file wrapper estoppel as repeatedly set forth in the decisions of this Court and the Courts of these two Circuits.

It is believed that an authoritative ruling of this Court on the question here presented would be a valuable supplement to the opinion of this Court in *Exhibit Supply Company v. Ace Patents Corporation*, *supra*. In that case the

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\*"Claims of a patent are to be taken as they read, and are not limited by an amendment of the specification more particularly describing the device shown in the drawings to meet objections of the Patent Office, where the claims themselves are left unchanged." (Syllabus 9)

scope of the estoppel arising out of an amendment to the claims is authoritatively decided. A ruling by this Court on the estoppel created by amendments to the specifications will go far toward clarifying the whole subject.

### III.

**The question presented here is one of public interest.**

It has been generally accepted since the creation of the patent system in this country that the consideration which the patentee pays for the limited monopoly secured to him by his patent is the full disclosure in the specifications of his patent, of his invention. He is required by statute to "explain the principle thereof, and the best mode in which he has contemplated applying that principle" (R. S. 4888, U. S. C. Title 35, Sec. 33).

*Beidler v. United States*, 253 U. S. 447, 453 (1920):

"Ever since *Grant v. Raymond*, 6 Pet. 218, 247, it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent, for the reason that such a disclosure is necessary in order to give the public the benefit of the invention after the patent shall expire. The source of the power to grant patents, and the consideration for granting them, is the advantage which the public will derive from them, especially after the expiration of the patent monopoly, when the discoveries embodied in them shall become a part of the public stock of knowledge."

It is as much the duty of the Patent Office to require specifications and drawings to fully and adequately describe "the best mode of applying the principle" of the invention as it is to see to it that the claims do not cover



more than the applicant is entitled to. By our system the specification and claims are separate and distinct and a patent to a broad and basic invention should contain in its specification the same detailed disclosure in the full and exact terms required by the statute as a narrow patent to a small improvement in a highly developed industry.

If the rule of the Second Circuit as announced in this case is allowed to stand, inventors, when called upon to amplify their specification, will be reluctant to do so because they will thereby limit the claims, however broad their terms may be, to the specific details disclosed in the amended specification.

### Conclusion

It is urged, therefore, that the petition for writ of certiorari be granted.

Respectfully submitted,

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